

REMARKS

Reconsideration of the present application is requested on the basis of the following particulars.

1. Acknowledgment of Information Disclosure Statement - Returned Form PTO-1449

Applicants note that an initialed copy of form PTO-1449 indicating consideration of the references submitted in the Information Disclosure Statement filed on November 16, 2001 was not returned with the outstanding Office Action. Applicants respectfully request consideration of the references cited to the Examiner on the form PTO-1449 submitted on November 16, 2001. If the Examiner needs a copy of any one of the references cited on the form PTO-1449 filed on November 16, 2001, Applicants invite the Examiner to contact the undersigned attorney listed below.

It will be pointed out that Applicants submit another form PTO-1449 concurrently herewith, and acknowledgment of such references is also requested.

Accordingly, Applicant respectfully requests acknowledgment of the references cited in both the Information Disclosure Statements filed in this application in the next Official Action.

2. In the Specification

The specification has been amended to include appropriate section headings in accordance with U.S. practice. Acceptance of the amendments to the specification is requested in the next office communication from the Examiner.

3. In the Claims

Claims 1, 3-14, 16, 17, 19, 21-23, 27, 29 and 31 are currently amended. As evident in the List of Current Claims, the reference numerals originally found in the

claims have been voluntarily removed in accordance with U.S. claim drafting style. It will be noted, however, that in accordance with MPEP 608.01(m), the use of reference numerals is considered as having no effect on the scope of the claims and is thus considered acceptable under U.S. practice. Accordingly, the removal of the reference numerals in the List of Current claims is purely a voluntary amendment that does not narrow the scope of the claims.

It will be noted that reference to language in the claims including phrases “such as...” and “preferably...” has been removed. These voluntary amendments are not in response to a rejection by the Examiner, and moreover are not intended to limit the scope of the claims. Instead, the removal of such language clarifies the subject matter for which protection is sought and removes any exemplary uses of the features recited in the pending claims.

Claim 1 has been amended to include the subject matter of original claim 2. Claim 2 was considered as reciting allowable subject matter in the outstanding Office Action, and would be allowable if drafted in independent form including the limitations of the claims from whence it depends. Claim 2 has been cancelled without prejudice or disclaimer. Applicants have performed such an amendment in the current amendment, and it is submitted that claim 1 is allowable.

The dependency of claims 3-4 has been changed to depend from claim 1 in view of the cancellation of claim 2.

Claim 6 has not been amended to include any additional subject matter. As will be discussed more fully below, it will be submitted that claim 6 is fully patentable over the prior art cited in the Office Action. Claims 7 and 8 directly depend from claim 6, and are patentable based on their dependency from claim 6 and their individually recited features.

Claim 10 has also not been amended to include any additional subject matter. For similar reasons to those related to claim 6, it will be submitted that claim 10 is

fully patentable over the prior art cited in the Office Action. Claims 12 and 13 directly depend from claim 10, and are patentable based on their dependency from claim 10 and individually recited features.

Claims 9, 14, 16, 17, 19, 21 and 22 depend from claims 1, 6 or 10, and their patentability is based on their dependency from claims 1, 6 or 10, and individually recited features.

Claim 23 is presently allowed. New independent claims 36-38 recite the subject matter of claim 23 with the inventive features of claims 2, 6, and 10, respectively. It will be pointed out that the present specification on page 3, last full paragraph indicates that the security element can consist of a plastic foil, and thus have the features recited in claims 2, 6 and 10. It will be noted that claim 38 resembles allowed claim 31, with the exception that it relates to a foil instead of plastic pellets.

Claim 27 has been amended to include the features of claim 2. While claim 27 is directed to a multi-layer transfer material, the present specification describes that the security element may take the form of a multi-layer transfer element. In view of the incorporation of the subject matter of claim 2 into claim 27, this claim is considered allowable due to the allowability of the subject matter of claim 2.

Claim 29 has not been amended with the exception of the removal of the reference numerals shown therein.

Claim 35 has been cancelled without prejudice or disclaimer. New claims 39-41 are currently added in the List of Current Claims which positively recite methods for testing the documents presently recited in claims 1, 6, and 10, respectively. Applicants submit that since each of the documents recited in claims 1, 6, and 10 are considered patentable by Applicants, claims 38-41 are patentable for similar reasons.

Applicants respectfully request entry of the claim amendments and new claims discussed above in the next Office communication.

4. Rejection of Claims 1, 5-14, 17, 21, 27, 29 and 35 Under 35 U.S.C. § 102(b) As Being Anticipated by U.S. Patent 6,318,758 (Stenzel et al.)

Claims 1, 5-14, 17, 21, 27, 29 and 35 are considered to lack novelty in view of the Stenzel et al. disclosure. This rejection is traversed in view of the following observations.

Claim 1 has been amended to include the limitations of the allowable subject matter of claim 2. Thus no further discussion is considered necessary regarding this claim. Claim 5 depends from claim 1 and is thus considered similarly patentable.

Claim 6 is neither anticipated nor suggested by the Stenzel et al. disclosure. Claim 6 specifies that the document of value described therein includes an optically variable material and a feature substance that are disposed in "one layer" that is in the form of information.

The Stenzel et al. disclosure relates to a security document that has at least a first layer with gaps in the form of characters or patterns (negative writing) and a magnetic layer disposed below the first layer (col. 1, lines 8 to 11). The first layer may comprise an optically variable layer such as a hologram and a printing ink with effect pigments, such as interference layer pigments, liquid crystal pigments, or bronze powders (col. 5, lines 25 to 30). Two first layers (cover layers 4, 6) can be provided with the magnetic layer laying therebetween (col. 2, line 60 to col. 3, line 4).

While the magnetic layer in the Stenzel et al. disclosure may comprise a machine readable feature substance, such as a magnetic material, there is no description or suggestion in the Stenzel et al. disclosure to position both the optically variable material and the feature substance in one layer. On the contrary, the Stenzel et al. disclosure consistently illustrates in FIGS. 2 to 18 a plurality of different

embodiments wherein the magnetic layer 5, and the layers 4 and 6 displaying the optically variable effect are placed one on top the other. This is consistent with the reading of the Stenzel et al. disclosure since the cover layers 4 and 6 are provided to cover the magnetic layer 5.

Since the Stenzel et al. disclosure fails to describe or suggest an optically variable material and a feature substance in one layer, the Stenzel et al. disclosure cannot disclose or suggest that the one layer recited in claim 6 is in the form of information .

Accordingly, claim 6 is clearly patentable over the Stenzel et al. disclosure. Moreover, as discussed above in reference to the List of Current Claims, claims 29, 37 and 40 are patentable on the basis of the distinction of claim 6.

Turning to claim 10, this claim recites a document of value wherein the optically variable material and the feature substance are disposed in one layer. Moreover, this reference specifically recites that the "one layer" is a self-supporting plastic foil which is not taught by the Stenzel et al. disclosure. For similar reasons based on the distinction of claim 6 discussed above, claim 10 is also patentable in view of the recitation of the "one layer," and the feature that the "one layer" is a self-supporting plastic foil. Moreover, as discussed above in reference to the List of Current Claims, claims 38 and 41 are patentable on the basis of the distinction of claim 10.

Claim 27 is discussed above as presently reciting the allowable subject matter of claim 2. Accordingly, this claim is patentable over the Stenzel et al. disclosure.

Claim 29 is patentable over the Stenzel et al. disclosure for similar reasons discussed above in relation to claim 6. More specifically, claim 29 relates to a printing ink that includes a binder and optically variable material that conveys different color effects at different viewing angles with the printing ink additionally including at least one machine-readable feature substance that does not impair a

visually visible optically variable effect of the optically variable material. It follows that the optically variable material and the machine-readable feature substance are disposed in "one layer" when applied to a substrate.

Thus, the same observations regarding claim 6 apply to claim 29 with the sole difference being that claim 6 is directed to a document of value whereas claim 29 is directed to a printing ink used for printing a document of value.

Claim 35 has been cancelled and the reasons for the patentability of new claims 39-41 are discussed above.

While the Office Action refers to the adhesive layer 12 discussed in column 6, lines 23 to 38 in the Stenzel et al. disclosure as corresponding to a "binder of conductive material", Applicants respectfully disagree. It will be noted that the adhesive layer 12 is not specified as being composed of a conductive material. Moreover, the adhesive layer 12 should not be construed as a binder of an ink composition, in which context the term "binder" is used in the present application.

Next, the Office Action points out to column 5, lines 25 to 30 in making the argument that the Stenzel et al. disclosure describes a security element having two liquid crystal materials having different polarizations. It will be noted, however, that this section of the Stenzel et al. disclosure merely refers to liquid crystal pigments of which it is not known whether they have the same or different polarization. Instead, it is to be assumed that the pigments are of identical material, and therefore do not have the same polarization.

Lastly, the Office Action refers to column 3, lines 1-4 of the Stenzel et al. disclosure to demonstrate that the machine-readable feature substance is an IR-absorbent material. It will be noted, however, that there is no support for this statement in the Stenzel et al. disclosure. On the contrary, most optically variable materials, in particular liquid-crystal materials, are transparent in the IR-spectral region (see present specification, page 5, lines 5 to 6).

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In accordance with the observations related to the rejection of the claims in the Office Action in view of the Stenzel et al. disclosure, withdrawal of the rejections of the currently rejected claims is requested.

5. Conclusion

In view of the amendments to the claims, the new claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that the pending claims be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicants' Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Justin J. Cassell', written in a cursive style.

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